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Ex parte Jones

of claims 38 and 39 in application. Vacated and remanded.

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Appeal No. 2001-1839

Decided November 28, 2001

**PATENTS****[1] Patentability/Validity — Obviousness — Combining references (§ 115.0905)**

"Motivation" to combine teachings of prior art is not always required to support obviousness rejection under 35 U.S.C. § 103, since legally sufficient rationale for finding of obviousness may be supported by reason or suggestion in prior art, as well as motivation, to combine teachings.

**[2] Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — Rules and rules practice (§ 110.1105)****Patentability/Validity — Obviousness — Relevant prior art — In general (§ 115.0903.01)**

Patent examiner's citation of abstract in support of rejection without citation and reliance on underlying scientific article is generally inappropriate if both abstract and underlying document are prior art, and proper examination therefore should be based on underlying documents and translations, if necessary, since abstracts often are not written by author of underlying document, and may be erroneous; in present case, in which neither examiner nor applicant relies on underlying articles, Board of Patent Appeals and Interferences, in exercise of its discretion, will not obtain translations of underlying journal articles in order to evaluate merits of translations in first instance, since it is examiner's responsibility to obtain translations, and since review of translations by examiner and applicant may supply additional evidence as to whether there is legally sufficient reason, suggestion, teaching, or motivation to combine teachings of cited articles, and thus may eliminate need for appeal.

Patent application of Jones, serial no. 08/947,428.  
 [FN 1] Applicant appeals from examiner's rejection

[Editor's Note: The Board of Patent Appeals and Interferences has indicated that this opinion is not binding precedent of the board.]

Before Winters and William F. Smith, administrative patent judges, and McKelvey, senior administrative patent judge.

McKelvey, S.J.

**Decision on appeal under**

The appeal is from a decision of a primary examiner rejecting claims 38-39. We vacate and remand for action not inconsistent with views expressed herein.

**A. Findings of fact**

The record supports the following findings by at least a preponderance of the evidence. [FN2]

1. The claimed invention relates to a method of making organic chemicals.

2. The examiner has rejected claims 38-39 as being unpatentable under 35 U.S.C. § 103(a) over

\*1207 a) Horner,

b) Suri,

c) Endel'man,

d) Manthey and

e) Ota.

3. Horner is a 25-page technical journal article written in German.

4. The examiner has placed in the record a short English-language abstract of Horner.

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5. The record does not contain an English-language translation of Horner.
6. Suri is a 2-page technical journal article written in English.
7. Endel'man is a 4-page technical journal article written in Russian.
8. The examiner has placed in the record a short English-language abstract of Endel'man.
9. The record does not contain an English-language translation of Endel'man.
10. Manthey is a 5-page technical journal article written in English.
11. Ota appears to be a 5-page technical journal article written in Japanese.
12. The examiner has placed in the record a short English-language abstract of Ota.
13. The record does not contain an English-language translation of Ota.
14. The examiner does not maintain that any one of the five prior art references fully describes the claimed invention. Hence, a rejection based on 35 U.S.C. § 103(a).
15. According to the examiner, "the skilled artisan looking for an alternative route for the preparation" of the product produced by the claimed method "was deemed to be aware of all the various methods of the preparation" of the product (Examiner's Answer, page 4).
16. Further according to the examiner, "one of ordinary skill in the art would be motivated [sic--would have been motivated] to prepare \*\*\* [the compound made by applicant's claimed method] by coupling Suri's \*\*\* acid and Endel'man's \*\*\* acid as taught by Manthey followed by \*\*\* [further treatment] to yield \*\*\* [a compound] as taught by Horner and subsequent reduction as taught by Ota to arrive at the \*\*\* [claimed process]" (Examiner's Answer, pages 4-5).
17. According to applicant, the requisite "motivation" is not present in the prior art because

"[t]hroughout the prosecution the examiner has failed to point out any teaching or suggestion in the prior art that would motivate the skilled artisan" to use the claimed process invention (Appeal Brief, page 4).

## B. Discussion

### 1. Rationale in support of obviousness

[1] The applicant and the examiner have apparently assumed that there always must be "motivation" to combine teachings of the prior art to support a rejection based on § 103(a). The assumption is not correct. The word "motivation" or a word similar to "motivation" does not appear in 35 U.S.C. § 103(a). While a finding of "motivation" supported by substantial evidence probably will support combining teachings of different prior art references to establish a *prima facie* obviousness case, it is not always necessary. For example, where a claimed apparatus requiring Phillips head screws differs from a prior art apparatus describing the use of flathead screws, it might be hard to find motivation to substitute flathead screws with Phillips head screws to arrive at the claimed invention. However, the prior art would make it more than clear that Phillips head screws and flathead screws are viable alternatives serving the same purpose. Hence, the prior art would "suggest" substitution of flathead screws for Phillips head screws albeit the prior art might not "motivate" use of Phillips head screws in place of flathead screws.

What must be established to sustain an obviousness rejection is a legally sufficient rationale as to why the claimed subject matter, as a whole, would have been obvious notwithstanding a difference between claimed subject matter and a reference which is prior art under 35 U.S.C. § 102. Once a difference is found to exist, then the examiner must articulate a legally sufficient rationale in support of a § 103(a) rejection. The legally sufficient rationale may be supported by a reason, suggestion, teaching or motivation in the prior art which would have rendered obvious the claimed subject within the meaning of § 103(a). *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the

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applicant); *In re Gartside*, 203 F.3d 1305, 1319, 53 USPQ2d 1769, 1778 (Fed. Cir. 2000) (the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a teaching or motivation to combine prior art references); *Pro-Mold and \*1208Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996) ("there must be a reason, suggestion, or motivation \*\*\* to combine [the teachings of] \*\*\* references \*\*\*"); *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999) (there is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention; the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the teachings of the references).

Moreover, when an examiner maintains that there is an explicit or implicit teaching or suggestion in the prior art, the examiner should indicate where (page and line or figure) such a teaching or suggestion appears in the prior art. *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993), citing *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981).

One difficulty with the rationale in support of the examiner's rejection in this case, and for that matter the applicant's challenge to the rejection, is that it appears to be based solely on a motivation rationale without taking into account whether there otherwise is a legally sufficient reason, showing, suggestion or teaching which might also suffice to support the examiner's rejection. Moreover, a suggestion, teaching or motivation to combine teachings of the prior art may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). See also *In re Gartside*, supra at 1319, 53 USPQ2d at 1778 (the suggestions may come from, *inter alia*, the teachings of the references themselves and, in some cases, from the nature of the problem to be solved).

If the examiner determines that it is appropriate to

enter a further rejection, the examiner may wish to consider a rationale based on a suggestion, teaching or other reason in place of a rationale based exclusively on motivation.

We will also note that the examiner's theory of rejection, at least in part, seems to rely on the proposition that if a person of ordinary skill in the art is looking for an alternative method for the preparation of a compound, then that person would be aware of all analogous art ( see Finding 15). If the examiner continues to rely on that theory, then the examiner would be under a burden to establish why a person of ordinary skill in the art would be looking for an alternative method, particularly where a method is known for making a particular compound.

## 2. Use of abstracts in place of

The principal difficulty with the prosecution of the application on appeal is the examiner's attempt to establish "motivation" by reliance on three English-language abstracts of journal articles written in foreign languages. The examiner does not maintain that only Suri and Manthey, both in English, support the rejection. The use of abstracts, when the underlying document is prior art, gives us considerable pause.

The Board of Patent Appeals and Interferences continues to have recurring problems in resolving ex parte appeals which come before it. One continuing recurring problem is the citation and reliance by examiners on abstracts, without citation and reliance on the underlying scientific document.

[2] In this appeal, the examiner relied upon abstracts of three technical journal articles without referring to translations of the underlying documents. Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. Abstracts often are not written by the author of the underlying document and may be erroneous. It is our opinion that a proper examination under 37 CFR § 1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and

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rely on the underlying document.

When an examiner cites and relies only on an abstract, the applicant may wish to obtain a copy of the underlying document and submit a copy to the examiner when responding to a rejection relying on an abstract. In the event a reference is in a foreign language, if the applicant does not wish to expend resources to obtain a translation, the applicant may wish to request the examiner to supply a translation. If a \*1209 translation is not supplied by the examiner, the applicant may wish to consider seeking supervisory relief by way of a petition (37 CFR § 1.181) to have the examiner directed to obtain and supply a translation.

In the past, when neither the examiner nor the applicant relies on the underlying article, the board often expended the resources necessary to obtain a copy of the underlying scientific article, as well as translations thereof. When it did so, however, the burden of examining the application fell on the board in the first instance. Moreover, to the extent that the board relies on parts of a translation not previously provided to an applicant, any affirmation generally has to be a new ground of rejection under 37 CFR § 1.196(b)—which can result in further prosecution.

In this case, we do not know whether the examiner or the applicant had or reviewed the underlying foreign language technical journal articles or translations thereof. The board cannot examine, in the first instance, all applications which come before it in an ex parte appeal under 35 U.S.C. § 134. In this particular appeal, we exercise discretion by declining to obtain translations of the underlying technical journal articles and thereafter evaluate on the merits in the first instance the translations. In our view, obtaining translations is the responsibility of the examiner. A review by the examiner and applicant of translations of the prior art relied upon in support of the examiner's rejection may supply additional relevant evidence as to whether there is a legally sufficient reason, suggestion, teaching or motivation to combine the teachings of the five technical journal articles. Moreover, an evaluation of translations may eliminate the need for an appeal.

#### C. Decision

The decision of the examiner rejecting claims 38-39 under 35 U.S.C. § 103(a) over (1) Horner, (2) Suri, (3) Endelman, (4) Manthey and (5) Ota is vacated and the application is remanded to the examiner. For the effect of a decision vacating an examiner's rejection, see *In re Zambrano*, 58 USPQ2d 1312 (Bd. Pat.—App. & Int. 2001) (explaining that vacated rejection no longer exists).

The examiner and/or the applicant may obtain translations of (A) Horner, (B) Endelman and (C) Ota.

Nothing in this opinion should be read as precluding the examiner from entering a rejection based on translations. In the event the examiner determines that claims 38-39 are unpatentable over the combination of the five references (or any additional prior art), then the examiner must identify and cite the specific portions (page and line or figure) of each article or prior art document upon which he relies in support of any rejection. We are primarily a board of review. Accordingly, neither the examiner nor applicant should expect in any further appeal for us to dig through five prior art references to come up with a theory which might support or negate a rejection in the first instance. Moreover, if the examiner enters a further rejection based on foreign language document, translations must be obtained if a further appeal is taken. We will not decide a further appeal without translations.

We express no views on the ultimate merits of any rejection under 35 U.S.C. § 103(a) based on the five prior art references or any additional prior art which the examiner and applicant may wish to make of record.

#### D. Order

Upon consideration of the appeal, and for the reasons given, it is

ORDERED that the examiner's rejection under § 103(a) of claims 38-39 is vacated.

FURTHER ORDERED that the application is remanded to the examiner for action not inconsistent with the views expressed in this opinion.

FURTHER ORDERED that no time period for

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taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

VACATED and REMANDED

FN1. Application for patent filed 8 October 1997.

FN2. To the extent these findings of fact discuss legal issues, they may be treated as conclusions of law.

P.T.O. Bd.Pat.App. & Int.

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Ex parte Gambogi

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Appeal No. 2001-1022

Decided December 10, 2001

**PATENTS**

[1] Practice and procedure in Patent and Trademark Office – Board of Patent Appeals and Interferences – Rules (§ 110.1105)

Patentability/Validity – Obviousness – Relevant prior art – In general (§ 115.0903.01)

Rejection of claims in patent application under 35 U.S.C. § 103(a) must be vacated and remanded, since patent examiner has cited numerous references in support of rejection, but has not indicated what that prior art would have meant to person of ordinary skill in art, since examiner has not referred to specific portions of each of cited references, and since rejection therefore requires both applicants and Board of Patent Appeals and Interferences to speculate as to portions of each reference relied upon, and why those references would contain teaching, suggestion, motivation, or incentive leading to claimed invention; in entering any new rejection, examiner should adopt practice described in Manual of Patent Examining Procedure for setting forth Section 103(a) rejection in office action, and should reproduce rejected claim or claims with reference therein to column and line of each relevant prior art reference.

Patent application of Robert J. Gambogi, Steven W. Fisher, Edward A. Tavss, and Marilou T. Jozaki, serial no. 09/065,267. [FN1] Applicants appeal from examiner's final rejection of claims 1-15 in application. Vacated and remanded.

[Editor's Note: The Board of Patent Appeals and Interferences has indicated that this opinion is not binding precedent of the board.]

Before Winters and William F. Smith, administrative patent judges, and McKelvey, senior administrative patent judge.

McKelvey, S.J.

**Decision on appeal under**

The appeal is from a decision of a primary examiner rejecting claims 1-15. We vacate and remand for further proceedings not inconsistent with the views expressed in this opinion.

**A. Findings of fact**

The record supports the following findings by at least a preponderance of the evidence. [FN2]

**The invention**

1. The claimed invention relates to (1) a two-component dental composition and (2) a method of using the composition.

**The examiner's rejections**

2. According to the Examiner's Answer (Paper 11, [FN3] page 4), the rejection is set out in the Final Rejection (Paper 4).

3. The final rejection makes the following rejections (page 3):

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al. (I-II-III) or Fisher et al. U.S. 5,780,015 (details noted above) taken with any one of each of: Toy, newly cited, Fischer, Collins et al., or Norfleet et al. (I-VI) \* \* \*.

4. The rejection, stated in different terms, is as follows:

Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the following prior art references, each of which is a U.S. patent:

(1) Campbell I,

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(2) Campbell II,

(3) Campbell III or

(4) Fisher [FN4]

taken with any one of:

(a) Toy,

(b) Fischer,

(c) Collins,

(d) Norfleet I,

(e) Norfleet II,

(f) Norfleet III,

\*1211 (g) Norfleet IV,

(h) Norfleet V or

(i) Norfleet VI.

5. A person with rudimentary skills in mathematics will immediately appreciate the fact that the examiner has entered no less than 36 separate rejections (i.e., 4 times 9 equals 36).

6. According to the final rejection (page 4), each of the Norfleet patents is said to describe a hydroxide with a pH of 6 to 8, preferably 7. No reference is made to a column and/or line of any of the Norfleet patents.

7. Further according to the final rejection (page 4), Collins is said to describe the hydroxide and a pH of 6 to 8. No reference is made to a column and/or line of Collins.

8. Still further according to the final rejection (page 4), "especially" Fischer describes two other hydroxides and a pH of 4 to 9, preferably 5 to 7. No reference is made to a column and/or line of Fischer.

9. Certain compositions are said to be described by each of the three Campbell patents and Fisher.

10. There follows a reference to page 4, lines 1-7 of some document. The reference may be to page 4,

lines 1-6 of applicants' specification.

11. Claim 1 contains limitations reading a "component containing" two ingredients and a "component containing" one ingredient.

12. The examiner asserts, without any underlying analysis, that "containing" is "open-ended", i.e., means "comprising." Ultimately, the examiner suggests that "containing" should be replaced with "consisting essentially of".

13. The examiner's final rejection is basically uninformative, if not unintelligible.

#### The appeal brief

14. Notwithstanding the vague nature of the final rejection, applicants make a reasonable attempt in the Appeal Brief (Paper 10) to explain why the final rejection is wrong.

15. Not without reason, applicants interpret the examiner's suggestion to replace "containing" with "consisting essentially of" as some form of rejection under 35 U.S.C. § 112, second paragraph. Ultimately, in the Examiner's Answer (Paper 11, page 9), the examiner attempts to make clear that no § 112 rejection was made.

16. With commendable patience, applicants attempt to address the examiner's rejections--rejections which basically cannot be addressed because they are so vague.

#### Examiner's answer

17. The Examiner's Answer (Paper 11) does little to clarify the examiner's otherwise vague rejections.

18. At one point in the Examiner's Answer (Paper 11, page 3), the examiner asserts that "the appealed claims clearly encompasses prior art \* \* \* patents \* \* \*" leaving the possible impression that one or more claims are unpatentable under 35 U.S.C. § 102 for anticipation.

19. The examiner says that claims 1-15 stand or fall together (Paper 11, page 3) when applicants make perfectly clear that claims 1-7 are one group

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(compositions claims) and claims 8-15 are another group (process claims).

20. In the Examiner's Answer, and for the first time in the prosecution, the examiner takes what we believe the examiner thought was official notice of a fact that certain salts are not stable in certain environments (page 4), citing § 2144.03 of the Manual of Patent Examining Procedure.

21. The examiner goes on to state, without citation to the page and line of any document, that applicants admit certain facts.

22. According to the examiner, one of the prior art references "admittedly discloses" certain facts, although absolutely no reference is made to a column and/or line of the reference or where the applicants are said to have made any admission.

23. Nothing in the Examiner's Answer clarifies in any material way the vague rejections made in the final rejection.

24. Interestingly enough, applicants filed no reply brief, and with good reason. We find no fault with applicants having declined to file a reply brief. We would have found it difficult, given the prosecution, to respond to the Examiner's Answer.

## B. Discussion

### 1.

The board in an ex parte appeal is basically a board of review--we review final rejections made by patent examiners. In order to have meaningful review, we must be able to understand the examiner's rejection, or in this case the examiner's 36 rejections. This appeal reminds us of *In re Herrick*, 344 F.2d 713, 145 USPQ 400 (CCPA 1965). There the CCPA said (id. at 716, 145 USPQ at 400):

We have begun our consideration of the rejections in this case with a purely numerical analysis, and we have ended it there, for, as will become apparent, the existing situation does not permit rational isolation and determination of the legal issues which may be present.

The CCPA went on to state (id. at 716, 145 USPQ at 401):

The form of the rejection would seem to indicate that many of the references were considered merely cumulative. And yet, the examiner's answer \* \* \* describe[s] and analyze[s] each reference in some detail. [FN5] Such a state of affairs places this court in a very real quandary. Are we to choose one individual rejection for each claim and turn the entire appeal on the correctness of those rejections? Or are we to work our way step-by-step through each rejection in the hope of finding one we can sustain? Neither alternative is satisfactory from the standpoint of the public interest.

\* \* \*

We decline to substitute speculation as to the rejection for the greater certainty which should come from the Patent Office in a more definite statement of the grounds of rejections. To the extent that the references are truly cumulative, the examiner or board can so indicate. If, on the other hand, all or most of the references are really necessary to meet the claims, the rejection can be made specific as to particular references.

What the CCPA said in *Herrick* applies to this case.

[1] There may be times when the use of numerous references can be justified. Cf. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991) (the criterion is not the number of references, but what they would have meant to a person of ordinary skill in the art). In this case, however, the examiner has not told applicants or the board what the prior art would have meant to a person skilled in the art. Moreover, the examiner has not referred to specific portions of each of the references. Cf. *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981), which the Federal Circuit in *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993), characterized as holding that when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art. Thus, both applicants and the board have to speculate as to the portions of each reference relied upon and why those references would contain a teaching, suggestion,

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reason, motivation or incentive leading to the claimed invention.

We decline to tell an examiner precisely how to set out a rejection. We recommend that in entering any new rejection in the application on appeal that the examiner adopt the practice set out in § 706.02(j) of the Manual of Patent Examining Procedure which contains a discussion of what an examiner should set forth in an Office action when making a rejection under 35 U.S.C. § 103(a). Moreover, we additionally recommend that the examiner use the practice set out in Ex parte Braeken, 54 USPQ2d 1110, 1112-1113 (Bd. Pat. App. & Int. 1999), i.e., reproducing the claim with reference therein to the column and line of a relevant prior art reference.

2.

There are numerous other difficulties with the appeal.

a.

We find it somewhat curious that the examiner found it necessary to cite and rely on Toy in the final rejection, while at the same time continuing to rely on numerous other possibly cumulative references. On the one hand, Toy is said to be necessary in view of amendments made by applicants (Paper 4, page 4). On the other hand, the examiner continues to alternatively rely on Fischer, Collins or any one of the six Norfleet patents. If Toy contains disclosure not contained by Fischer, Collins or the six Norfleet patents and Toy is necessary to meet the claims as amended, then why would it be necessary to continue to rely on Fischer, Collins and the six Norfleet patents.

\*1213 b.

We also find that the examiner appears to have taken official notice of certain facts in the first instance in the Examiner's Answer. Taking official notice of facts for the first time in an Examiner's Answer would not appear to be consistent with the complete examination required by 37 CFR § 1.104. If the facts officially noticed are necessary, the time for taking official notice is in the first action when an applicant has a meaningful opportunity to challenge the correctness of the fact officially noted.

c.

The examiner has alleged that applicants have admitted certain facts. When an examiner alleges that an applicant has admitted certain facts, the examiner is manifestly under a burden of citing the precise page and line of the document in which the admission occurred. Otherwise, the applicant will have difficulty addressing any issue of whether an admission has been made.

We recognize that in this case the examiner could say that applicants had an opportunity in a reply brief to challenge the correctness of the fact officially noted and the facts said to have been admitted. While it is true that applicants did not file a reply brief in this appeal, it is also true that the examiner's rejection is so vague that filing of a reply brief might well have been considered a futile act on the part of the applicants. Nothing in the Examiner's Answer materially clarified the vague final rejection. Hence, the absence of a reply brief is no basis upon which to penalize applicants in this particular case. It is not an applicant's responsibility to set out a clear and concise rejection in their reply brief--setting out a rejection is the responsibility of the examiner.

d.

In the final rejection, the examiner held that "containing" is an open-ended "transitional" phrase having the same meaning as "comprising" (Paper 4, page 3). The issue of whether "containing" is open-ended, like "comprising," or means something else, like "consisting essentially of" or "consisting", is a matter which should be evaluated on a case-by-case basis. Cf. the discussion under OTHER TRANSITIONAL PHRASES in § 2111.03 of the Manual of Patent Examining Procedure (discussing prior court interpretations of "having" and "composed of"). See also Crystal Semiconductor Corp. v. Tritech Microelectronics International, Inc., 246 F.3d 1336, 1348 (Fed. Cir. 2001) ("having" does not create a presumption that the body of the claim is open; rather the claim must be examined in its full context to determine whether "having" limits the claims to its recited elements); AFG Industries, Inc. v. Cardinal IG Co., Inc., 239 F.3d 1239, 1245, 57 USPQ2d 1776, 1780 (Fed. Cir. 2001) ("composed of" in this case was interpreted

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to be the same as "consisting essentially of").

C. Order

Upon consideration of the appeal, and for the reasons given, it is

ORDERED that the examiner's rejection of claims 1-15 over the prior art as set out in the final rejection is vacated. [FN 6]

FURTHER ORDERED that the application is remanded to the examiner for action not inconsistent with the views expressed in this opinion.

FURTHER ORDERED that nothing in this opinion should be read as precluding the examiner from entering a new rejection.

FURTHER ORDERED that we express no views on the ultimate merits of any rejection under 35 U.S.C. § 103(a) based on the prior art references or any additional prior art which the examiner and applicant may wish to make of record.

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**VACATED and REMANDED**

FN1. Application for patent filed 23 April 1998. The real party in interest is Colgate-Palmolive Co. (Appeal Brief, page 2).

FN2. To the extent these findings of fact discuss legal issues, they may be treated as conclusions of law.

FN3. The "contents" of the file wrapper of the application on appeal identify the Examiner's Answer as Paper 11. The Examiner's Answer, on the other hand, bears "Paper No. 10". According to the "contents," the Appeal Brief is Paper 10.

FN4. The reader should be aware that the examiner has relied on a "Fischer" and a "Fisher" reference which are different references.

FN5. In the appeal before us, apparently unlike the appeal in Herrick, the examiner has not analyzed each reference in any meaningful detail.

FN6. The effect of a decision vacating an examiner's rejection is explained in *In re Zambrano*, 58 USPQ2d 1312 (Bd. Pat. App. & Int. 2001) (noting that vacated rejection no longer exists).

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